

Remarks:

Applicants appreciatively acknowledge the Examiner's confirmation of receipt of Applicants' claim for priority and certified priority document under 35 U.S.C. § 119(a)-(d).

Reconsideration of the application, as amended herein, is respectfully requested.

Claims 1 - 5 and 8 - 11 are presently pending in the application.

In paragraph 1 of the above-identified Office Action, claims 1 - 6 were rejected under 35 U.S.C. § 103(a) as allegedly being obvious over U. S. Patent No. 6,173,334 to Matsuzaki et al. ("MATSUZAKI") in view of U. S. Patent No. 6,434,618 to Cohen et al ("COHEN").

In paragraph 2 of the Office Action, claims 7 - 11 were indicated as being allowable if rewritten to include all the limitations of the claims from which those claims depend.

Claim 1 has been amended to incorporate the limitations of dependent claim 7, which was indicated as allowable, and the limitations of dependent claim 6, which intervened between claim 7 and claim 1. Claim 10, indicated as being allowable, has been amended into independent form, including the

limitations of all claims from which it originally depended. Claims 6 and 7 have been canceled. Claim 8 has been amended to depend from claim 1, instead of canceled claim 7. As such, it is believed that all claims presently pending in the application are in a form that was indicated in the Office Action as being patentable over the cited art.

On page 2 of the above-identified Office Action, claim 1 was rejected as being indefinite under 35 U.S.C. § 112, second paragraph. More specifically, it was stated in the Office Action that the subject matter in claim 1 "checking a sender network address to determine whether a sender network address is intended for address conversion" was allegedly not described in the specification in such a way as to enable one skilled in the art to make and/or use the invention. Applicant respectfully disagrees with the statement in the Office Action.

The claimed feature of "checking a sender network address to determine whether a sender network address is intended for address conversion" is fully described in the specification of the instant application. See, the instant application, page 20, line 17 - page 22, line 10. In connection with a first exemplary embodiment of the instant application, address conversion is to be carried out when a corresponding routing

entry exists and is provided with an ADR-MAP-FLAG. See, more particularly, the instant application, page 20, line 17 - page 21, line 4.

The instant application also discloses a second exemplary embodiment wherein an entry of the target address in the service list is used to decide whether an address conversion is to take place. On page 15, lines 17 - 21 of the instant application, this second exemplary embodiment is described, as follows:

"In contrast to the first exemplary embodiment, a service list with the sender network addresses intended for address conversion is, in the second exemplary embodiment, stored in each of the communications systems PBX-A, PBX-B." [emphasis added by Applicants]

See also, the instant application, page 21, lines 12 - 18. In the case of the second exemplary embodiment, the entry is also connected with a corresponding ADR-MAP-FLAG.

As such, the instant application fully teaches one skilled in the art how to make the claimed invention. In fact, two exemplary embodiments are given on how to check "a sender network address to determine whether a sender network address is intended for conversion." The method of checking was particularly clear enough for the following statement to have been made in the Office Action:

"[in] the specification, detail of checking is the [sic] address intended for address conversion is identified by the conversion identification ADR-MAP-FLAG (see section 0036 and 0043) to advance a skill in the art"

The Office Action, itself, supports the fact that one skilled in the art reading the instant specification would understand how to make at least two particular embodiments of the presently claimed invention. It is accordingly believed that the specification and the claims of the instant application meet the requirements of 35 U.S.C. § 112, second paragraph. However, the fact that the two different exemplary embodiments disclosed in the instant specification use the ADR-MAP-FLAG to identify addresses intended for conversion, does not make the particularly described and exemplary ADR-MAP-FLAG a limitation of the claims. It would be improper to read the limitation of the ADR-MAP-FLAG into Applicants' claims, and Applicant respectfully disagrees with the rejection of claim 1 under 35 U.S.C. § 112, and with the subsequent statement in the Office Action interpreting "checking a sender network address" to mean "checking the conversion identification Flag."

In view of the foregoing, reconsideration and allowance of claims 1 - 5 and 8 - 11 are solicited.

In the event the Examiner should still find any of the claims to be unpatentable, counsel would appreciate receiving a telephone call so that, if possible, patentable language can be worked out.

If an extension of time for this paper is required, petition for extension is herewith made.

Please provide any additional extensions of time that may be necessary and charge any other fees that might be due with respect to Sections 1.16 and 1.17 to the Deposit Account of Lerner and Greenberg, P.A., No. 12-1099.

Respectfully submitted,



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